APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/751,194	12/31/2003	Garrett R. Goldfield	37202/273001; 990063	2548

57956   7590   03/31/2010
OSHA - LIANG L.L.P. (INTUIT)
TWO HOUSTON CENTER
909 FANNIN STREET, SUITE 3500
HOUSTON, TX 77010

EXAMINER
DAM, KIM LYNN

ART UNIT	PAPER NUMBER
2179	

NOTIFICATION DATE	DELIVERY MODE
03/31/2010	ELECTRONIC

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docketing@oshaliang.com
lord@oshaliang.com
hathaway@oshaliang.com

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

_____

Ex parte GARRETT R. GOLDFIELD, WILLIAM K. SCARVIE III,
DAVID MURRAY and TODD HASEYAMA

_____

Appeal 2009-005533
Application 10/751,194
Technology Center 2100

_____

Decided: March 29, 2010

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Before JEAN R. HOMERE, ST. JOHN COURTENAY III, and THU A.
DANG, *Administrative Patent Judges*.

DANG, *Administrative Patent Judge*.

DECISION ON APPEAL

I. STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134 (2002) from a Final Rejection of claims 1-8, 10, 11, 13-18, 20, 21, and 23-27. Claims 9, 12, 19, and 22 have been canceled. We have jurisdiction under 35 U.S.C. § 6(b) (2008).

We affirm.

A. INVENTION

According to Appellants, the invention generally relates to help features provided for a software application, an example of which is a web application (Spec. 1, ¶ [0001]).

B. ILLUSTRATIVE CLAIM

Claim 1 is exemplary and is reproduced below:

1.   A computer-implemented method of providing help information for a software application, comprising:

maintaining a user help knowledge base, wherein said maintaining comprises creating a plurality of data entries, wherein each data entry of said plurality of data entries comprises data indicating:

help information presented to a user by said software application in response to a selection of a help information file comprising the help information;

a presentation mode selected by the user, wherein said help information is presented to the user according to said presentation mode selected by the user; and

an application context, wherein the application
context is a portion of said software application
executing during said selection of the help information
file;

selecting additional help information for presentation to a
user based on a particular entry of the user help knowledge base
including help information previously selected by a user as
indicated by said particular entry;

determining a presentation mode for the additional help
information based on said particular entry of the user
knowledge base including a presentation mode of help
information previously selected by the user as indicated by said
particular entry; and

presenting the additional help information according to
the determined presentation mode.

C. REJECTIONS

The prior art relied upon by the Examiner in rejecting the claims on

appeal is:

Garber	4,905,163	Feb. 27, 1990
Weinlaender	2002/0015056 A1	Feb. 7, 2002

Claims 1-8, 10, 11, 13-18, 20, 21, and 23-27 stand rejected under 35

U.S.C. § 103(a) over the teachings of Weinlaender in view of Garber.

II. ISSUE

Did the Examiner err in finding that the combination of Weinlaender

and Garber teaches or would have suggested maintaining a user help

knowledge base, each data entry comprising data indicating "help information presented to a user by said software application in response to a selection of a help information file" and "an application context, wherein the application context is a portion of said software application executing during said selection of the help information file" (claim 1), as Appellants contend? The issue turns on whether Weinlaender teaches or at the least would have suggested "help information presented to a user" and "application context" as required by claim 1.

III. FINDINGS OF FACT

The following Findings of Fact (FF) are shown by a preponderance of the evidence.

Weinlaender

1. Weinlaender discloses a help system in which a user can access the utilization functions in an application program, wherein the frequency and/or the types of access to the utilization functions are recorded and used to generate a user profile data set (p. 2, ¶ [0021]).

2. Thus, a user can still access the available help topic data sets directly (*id.* at ¶ [0022]).

3. The recorded user profile data set allows for compiling a selection of help topics that are currently relevant to the user and tailored to the needs of the user (*id.* at ¶ [0023]).

4. Topic headings are selected based on information on the user's frequency and/or types of access to the utilization functions of the

applications, wherein this information is contained in the respective
user profile data set, and the content of the help startup page changes
since, based on changes in the user's access behavior, the
representation of the user's utilization focus or utilization habits is
also continuously changed (p. 3, ¶ [0028]).

5.   The help system is used in computer networks, wherein the computer
networks include those based on communication via the Internet (p. 4,
¶ [0039]).

IV. PRINCIPLES OF LAW

Claim Interpretation

"[T]he PTO gives claims their 'broadest reasonable interpretation.'"
In re Bigio, 381 F.3d 1320, 1324 (Fed. Cir. 2004) (quoting *In re Hyatt*, 211
F.3d 1367, 1372 (Fed. Cir. 2000)). "Moreover, limitations are not to be read
into the claims from the specification." *In re Van Geuns*, 988 F.2d 1181,
1184 (Fed. Cir. 1993) (citing *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir.
1989)). Our reviewing court has repeatedly warned against confining the
claims to specific embodiments described in the specification. *Phillips v.
AWH Corp.*, 415 F.3d 1303, 1323 (Fed. Cir. 2005) (en banc).

35 USC 103

Section 103 forbids issuance of a patent when "the differences
between the subject matter sought to be patented and the prior
art are such that the subject matter as a whole would have been
obvious at the time the invention was made to a person having
ordinary skill in the art to which said subject matter pertains."

KSR Int'l Co. v. Teleflex Inc., 550 U.S. 398, 406 (2007).

In *KSR*, the Supreme Court emphasized "the need for caution in granting a patent based on the combination of elements found in the prior art," and discussed circumstances in which a patent might be determined to be obvious. *Id.* at 415 (citing *Graham v. John Deere Co.*, 383 U.S. 1, 12 (1966)). The Court reaffirmed principles based on its precedent that "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *Id.* at 416. The Court noted that "[c]ommon sense teaches . . . that familiar items may have obvious uses beyond their primary purposes, and in many cases a person of ordinary skill will be able to fit the teachings of multiple patents together like pieces of a puzzle." *Id.* at 420. "A person of ordinary skill is also a person of ordinary creativity, not an automaton." *Id.* at 421.

The Federal Circuit recently recognized that "[a]n obviousness determination is not the result of a rigid formula disassociated from the consideration of the facts of a case. Indeed, the common sense of those skilled in the art demonstrates why some combinations would have been obvious where others would not." *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161 (Fed. Cir. 2007) (citing *KSR*, 550 U.S. at 416). The Federal Circuit relied in part on the fact that Leapfrog had presented no evidence that the inclusion of a reader in the combined device was "uniquely challenging or difficult for one of ordinary skill in the art" or "represented an unobvious step over the prior art." *Id.* at 1162 (citing *KSR*, 550 U.S. at 418).

One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986).

V.   ANALYSIS
Claims 1-3, 6-8. 10, 21 and 24

Appellants contend that "'said selection' in claim 1 recites a selection of a help information file for help information that has already been 'presented' to the user" and thus "'said selection' in claim 1 refers to a prior selection" (App. Br. 12). Thus, Appellants contend that "Weinlaender has <u>absolutely nothing to do</u> with each data entry also comprising data indicating an <u>application context</u> that is <u>a portion of said software application</u> *executing during the past selection* <u>of the help information file</u>" (*id.*). Furthermore, Appellants contend that though Weinlaender provides examples of the "types of access" recorded in his user profile data set, "none of which are the same as an application context, wherein the application context is a portion of said software application executing *during said selection of the help information file*" (App. Br. 14). Finally, Appellants contend that "the Examiner has not stated a proper reason as to why one or [sic] ordinary skill in the art would combine the teachings of Garber with the teachings of Weinlaender" (App. Br. 15).

However, the Examiner explains that "Weinlaender teaches keeping track of frequency and types of user's access to functions and/or help topic data sets…, which means those selections had to have been made in the past

in order to be tracked/recorded" (Ans. 16). That is, according to the Examiner, "selected help data topic sets [of Weinlaender] are help information presented to the user" wherein the system "uses this information to present additional help information to a user depending on the application context in order to provide users with help topics that are currently relevant to the user or currently needed help topics" (*id.*). Thus, according to the Examiner, "[i]n order to determine currently needed topics, the application context must be kept track of" (*id.*). The Examiner also finds that "it would have been obvious to incorporate the teachings of Garber into the system of Weinlaender since doing so would allow help information to be presented in modes according to the user's typical preferences" (Ans. 18-19).

Thus, the issue we address on appeal is whether the combination of Weinlaender in view of Garber teaches or would have suggested maintaining a user help knowledge base, each data entry comprising data indicating "help information presented to a user by said software application in response to a selection of a help information file" and "an application context, wherein the application context is a portion of said software application executing during said selection of the help information file" (claim 1). In particular, we address whether Weinlaender teaches or at the least would have suggested "help information presented to a user" and "application context" as required by claim 1.

We give the claims their broadest reasonable interpretation. *See In re Bigio*, 381 F.3d at 1324. Furthermore, our analysis will not read limitations

into the claims from the specification. *See In re Van Geuns*, 988 F.2d at 1184.

Appellants' claims simply do not place any limitation on what the terms "help information" and "application context" are to be, are to represent, or are to mean, other than that the help information is "presented to a user by said software application in response to a selection of a help information file" and the application context "is a portion of said software application" (claim 1). Thus, the help information and the application context cannot be confined to a specific embodiment when the claims do not recite a specific embodiment. Instead, we interpret "help information" as any information that is presented to a user by the software application in response to a selection, and "an application context" as any portion of the software application.

Weinlaender discloses a help system in which a user can access the utilization functions in an application program and the frequency and/or the types of access to the utilization functions are recorded and used to generate user profile data sets (FF 1). The recorded user profile data sets allow for compiling a selection of help topics that are currently relevant to the users and tailored to the needs of the users (FF 3).

An artisan skilled in the art would have understood the user's access to the utilization functions in an application program of the help system to be the user's selection of a help information file, wherein the help information is presented to the user by the software application. Further, since the recording of the user profile data sets occurs *prior to* retrieving the user

profile data sets, the skilled artisan would also have understood Weinlaender's recording of user profile data sets by compiling a selection of help topics that are tailored to the needs of the users to be a step of maintaining a user help knowledge base that comprises data of the user's past activities. That is, the user activities must _have occurred already_ in order for the activities to be recorded.

Accordingly, we find that Weinlaender does disclose maintaining a user help knowledge base, wherein the recorded data comprises help information presented to a user by the software application in response to a selection of a help information file, as required by claim 1. That is, we agree with the Examiner since "Weinlaender teaches keeping track of frequency and types of user's access to functions and/or help topic data sets… those selections had to have been made in the past in order to be tracked recorded" (Ans. 16).

In Weinlaender, with the recording of the user profile data sets, a user can still access the available help topic data sets (FF 2). The skilled artisan would also have understood Weinlaender to provide the available help topic data sets for _future_ activities. That is, we agree with the Examiner's finding that Weinlaender's "selected help data topic sets are help information presented to the user" wherein the system "uses this information to present additional help information to a user depending on the application context in order to provide users with help topics that are currently relevant to the user or currently needed help topics" (Ans. 16).

Furthermore, a skilled artisan would have understood that a software application comprises a plurality of data sets that are executed with the software application. Weinlaender discloses data sets that are executed with the application software and that comprise a portion of the application software (FF 1-3). Thus, we find Weinlaender to comprise an application context that is a portion of the application software. Further, since Weinlaender records the data sets from previous selections (*id.*), we find that a portion of the software application that was executed in a previous selection is recorded in Weinlaender. Thus, given our aforementioned claim construction, we find Weinlander to comprise the "application context" as required by claim 1.

Appellants further contend that "the cited art does not teach or suggest determining a presentation mode for the additional help information based on said particular entry of the user knowledge base" because "Garber certainly does not teach data entries according to the specific limitations of claim 1." (App. Br. 14-15.) Appellants appear to be arguing that, *individually*, Garber does not disclose the features of claim 1. However, the Examiner rejects claim 1 over the combined teachings of Weinlaender and Garber, and what the combined teachings would have suggested to one of ordinary skill in the art. Appellants cannot show nonobviousness by attacking Garber individually where the rejection is based on combinations of Weinlaender and Garber. *See In re Merck*, 800 F.2d at 1097.

As discussed above, we agree with the Examiner's finding that
Weinlaender discloses providing additional help information based on the
particular entry of the user knowledge base (FF 1-3). The Examiner relies
on Garber as a secondary reference to provide "monitoring users
presentation mode preferences in order to incorporate these preferences into
future interaction with the user" (Ans. 18). One of ordinary skill in the art
would have understood Garber to disclose "determining a presentation
mode," and thus, would have understood Weinlaender in view of Garber to
disclose or at the least suggest "determining a presentation mode for the
additional help information based on said particular entry of the user
knowledge base" as required by claim 1.

Appellants also argue that "the Examiner has not stated a proper
reason as to why one or [sic] ordinary skill in the art would combine the
teachings of Garber with the teachings of Weinlaender" (App. Br. 15.)
We find that the combination of one known element (determining a
presentation mode as taught by Garber) with another known element (the
providing of help information of Weinlaender) would have yielded nothing
more than predictable results to one of ordinary skill in the art at the time of
the invention. That is, we find that providing a presentation mode as taught
by Garber for the help information of Weinlaender is no more than a simple
arrangement of old elements, with each performing the same function it had
been known to perform, yielding no more than one would expect from such
an arrangement. *See KSR*, 550 U.S. at 417.

Appellants have presented no evidence that using Garber's
presentation mode with Weinlaender's providing of help information was
"uniquely challenging or difficult for one of ordinary skill in the art" or
"represented an unobvious step over the prior art." *Leapfrog*, 485 F.3d at
1162 (citing *KSR*, 550 U.S. at 418-19). Rather, as the Examiner finds, "it
would have been obvious to incorporate the teachings of Garber into the
system of Weinlaender since doing so would allow help information to be
presented in modes according to the user's typical preferences" (Ans. 18-
19).

Accordingly, we find that the Examiner did not err in rejecting
independent claim 1, independent claim 21 falling therewith, and dependent
claims 2, 3, 6-8, 10 and 24 respectively depending therefrom, under 35
U.S.C. § 103(a).

Claims 11, 13, 16-18 and 20

Appellants reiterate the same arguments for claim 11 as those to claim
1 (App. Br. 18-21), and add that Weinlaender and Garber do not teach or
suggest "a *current* application context that indicates a portion of the software
application *currently* executing" (App. Br. 18). However, the Examiner
finds that "in the Weinlaender reference, the current application is clearly
taught" (Ans. 21). In particular, the Examiner finds that "Weinlaender keeps
track frequency/type of access to help topic data sets … and the application
context during selections in order to determine the users currently needed
and currently relevant topics" (*id.*). Thus, according to the Examiner, "[t]he
system of Weinlaender has to know where the user is currently in the

application" and "what users have selected in the past to 'coach' them with
information they currently need" (*id.*).

We agree with the Examiner. In particular, Weinlaender discloses
recording the user profile data sets, wherein a user can still access the
available help topic data sets for current selection (FF 2). A skilled artisan
would have understood the user's activity on the help system to be with
respect to an executing software application, and thus, would have
understood the current user selection to comprise selecting based on a
portion of the software application currently executing. Thus, we find
Weinlaender to disclose selecting particular help information based on an
application context that indicates a portion of the software application
currently executing, as required by claim 11.

Accordingly, we also find that the Examiner did not err in rejecting
claims 11 and claims 13, 16-18 and 20 depending therefrom over
Weinlaender in view of Garber under 35 U.S.C. § 103(a).

<div align="center">*Claims 4, 14, 26 and 27*</div>

With respect to claim 4, Appellants contend that "nowhere does
Weinlaender mention anything at all about help rules, much less *prioritizing*
the additional help information for presentation *based on* the user help
knowledge base *and one or more help rules* each associated with a change in
application context of the software application" (App. Br. 16). Appellants
repeat similar contentions with respect to claims 14, 26, and 27 (App. Br.
21-22 and 25-26).

However, the Examiner finds that "in order to provide users with help topics that are currently relevant to the user … or currently needed help topics …, there must be some type of prioritizing in order to choose which information to present depending on the context of the application" (Ans. 19). That is, according to the Examiner, "[t]he system of Weinlaender knows where users are currently in the application, knows what help topics they previously selected, and then prioritizes information to present to them what they currently need or what is currently relevant" (*id.*).

We agree with the Examiner. In particular, Weinlaender discloses that the help information presented to the user is changed since the representation of the user's utilization focus or utilization habits is also continuously changed (FF 4). A skilled artisan would have understood changing of the help information based on the user's focus and utilization habits to comprise prioritizing the information based on the user's focus and habits. Thus, the skilled artisan would also have understood the changing/prioritizing to be based on the stored user profile and the changes within the recorded data sets, i.e., application context of the software application. Thus, we find Weinlaender to disclose prioritizing the help information for presentation based on the user help knowledge base and help rules associated with a change in application context of the software application.

Accordingly, we also find that the Examiner did not err in rejecting claims 4, 14, 26, and 27 over Weinlaender in view of Garber under 35 U.S.C. § 103(a).

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Claims 5, 15 and 25

With respect to claim 5, Appellants contend that "nothing about the Internet inherently requires or even suggest the use of a third-party service provider in a manner according to the specific limitations of Appellants' claim" (App. Br. 17). Appellants repeat similar contentions with respect to claims 15 and 25 (App. Br. 22-23 and 24-25).

However, the Examiner finds that "[t]he skilled artisan knows that computer networks based on communication via the Internet would allow for help presentation from third-party service providers to be selected" (Ans. 20). That is, according to the Examiner, "[t]hird-party service providers are commonly used to provide additional information when there is not sufficient space or availability from the local system" (*id.*).

We agree with the Examiner. In particular, Weinlaender discloses that the help system is used on computer networks based on communication via the Internet (FF 5). We conclude that modifying the known teaching of selecting information in Internet-based computer networks with the known teaching of receiving information from a third-party would have yielded predictable results to one of ordinary skill in the art at the time of the invention. That is, we find that providing third-party information as the help information for selecting for presentation, as that of Weinlaender, yields no more than one would expect from such an arrangement. Appellants have presented no evidence that using third-party information as Weinlaender's help information was uniquely challenging or would have represented an unobvious step over the Weinlaender.

Accordingly, we also find that the Examiner did not err in rejecting claims 5, 15, and 25 over Weinlaender in view of Garber under 35 U.S.C. § 103(a).

<div align="center">*Claim 23*</div>

As to claim 23, Appellants repeat the argument that "the cited art fails to mention anything at all about the application context in which a help file is selected" (App. Br. 23). However, as discussed above, we agree with the Examiner that Weinlaender discloses such application context.

Accordingly, we also find that the Examiner did not err in rejecting claim 23 over Weinlaender in view of Garber under 35 U.S.C. § 103(a).

<div align="center">VI. CONCLUSIONS OF LAW</div>

(1) Appellants have not shown that the Examiner erred in concluding that claims 1-8, 10, 11, 13-18, 20, 21, and 23-27 are unpatentable under 35 U.S.C. § 103(a) over the teachings of Weinlaender in view of Garber.

(2) Claims 1-8, 10, 11, 13-18, 20, 21, and 23-27 are not patentable.

<div align="center">VII. DECISION</div>

We affirm the Examiner's rejection of claims 1-8, 10, 11, 13-18, 20, 21, and 23-27 under 35 U.S.C. § 103(a).

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

<div align="center">AFFIRMED</div>

peb

OSHA - LIANG L.L.P. (INTUIT)
TWO HOUSTON CENTER
909 FANNIN STREET, SUITE 3500
HOUSTON TX 77010